

## REMARKS

### I. Status of the Claims

Claims 25, 27, 30 and 31 are pending in the application. Claims 25, 30 and 31 stand rejected under 35 U.S.C. §102(b) over Suda as evidenced by Falzon. Claim 27 is objected to as pending. The specific grounds for objection/rejection, and applicants' response thereto, are set out in detail below.

### II. Rejection Under 35 U.S.C. §102

Claims 25, 30 and 31 stand rejected under §102 over Suda in view of Falzon. Applicants traverse.

Suda is cited as teaching a method of treating leukemia with 1,25-(OH)<sub>2</sub>D<sub>3</sub>. It is silent on the mechanism of action. Falzon is cited as disclosing that 1,25-(OH)<sub>2</sub>D<sub>3</sub> downregulates PTH-rP expression at the transcriptional level. Thus, Suda is clearly being advanced as *inherently* anticipating the instant claims, given the failure of that reference to mention anything regarding PTH-rP.

The flaws in the preceding analysis are many. First, it should be noted that no "patient" is treated in Suda. The only experimental evidence provided is on cell lines. Thus, regardless of what Suda might *suggest* one should do with 1,25-(OH)<sub>2</sub>D<sub>3</sub>, it clearly does not defeat the novelty of a therapeutic *method*, inherently or otherwise.

Second, and perhaps more importantly, applicants point out that the present claim is not drawn to a method of treating cancer, but to inhibiting bone destruction in a cancer patient. In order for inherent anticipation to stand, there must be a certainty, in hindsight, that the claimed method was performed. However, the existence of bone resorption in leukemia – the only

cancer discussed in Suda – is extremely rare. Thus, there is no basis for asserting that the reference in any way contemplated such a method, not to mention the fact that no patient was treated.

Third, applicants submit that once the novelty of the claims is acknowledged over Suda, there would be no basis for an obviousness rejection given the absence of any disclosure in Suda, the only *prior* art being cited, regarding prostate cancer, PTH-rP or bone resorption.

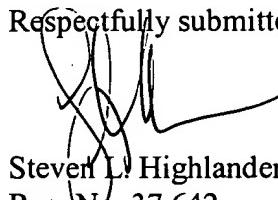
In light of the foregoing, applicants respectfully submit that Suda is not anticipatory of the present claims. Reconsideration and withdrawal of the rejection is respectfully requested.

### **III. Conclusion**

In light of the foregoing, applicants respectfully submit that all claim are in condition for allowance, and an early notification to that effect is earnestly solicited. The examiner is invited to contact the undersigned at the telephone number listed below with any questions, comments or suggestions relating to the referenced patent application.

Please date stamp and return the enclosed postcard as evidence of receipt.

Respectfully submitted,



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